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EXAMINER

CHAWLA, JYOTI

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/632,397	Applicant(s) FREEDMAN ET AL.	
	Examiner Jyoti Chawla	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "starch being able to withstand temperatures of 260°F", which is not clear because the criteria for what is considered "withstand" is not defined. The ability of starch or any other material to "withstand" a temperature is also very dependent on the time and nature of exposure. For example, if a starch is introduced in an oven, wherein the oven is at 260°F, and where the exposure time is only 1 second, the impact on the starch will be different from if the same starch is put on a hot plate at 260°F wherein the exposure time is 1 hour.

Claim 1 further recites "powder slurry". It is not clear what this means and how a "powder slurry" is different from a "slurry". For the purpose of this office action, it will be assumed that a "powder slurry" is the same as a "slurry".

Still further, claim 1 recites "at a sufficient temperature for a sufficient time to allow swelling of the starch". The recitation does not define the required extent of swelling.

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Further, specific temperature or time is also not recited. This makes the claim indeterminate. Note that some swelling, however small, of the starch will occur when water is added. Therefore, without knowing the extent of swelling required, it is not possible to determine the said "sufficient temperature for a sufficient time".

Claim 3 recites, "a 5% heated slurry of the starch", but does not completely define 5%; e.g. 5% by weight, which makes the claim indeterminate. Further, the last three words of the claim recite "after 15 minutes" but does not define after 15 minutes of what; e.g. after 15 minutes from the start of heating; or after 15 minutes of completion of heating, which also makes the claim indeterminate.

Claim 5 recites a "viscosity of about 10 cm to about 23 cm", but does not define what temperature the viscosity is measured at. It is well known that viscosity is dependent on temperature (as also evidenced by applicant's recitation in claim 3) and the lack of definition of the temperature at which viscosity is measured makes the claim indeterminate.

Claim 6, which depends from claim 1, recites "prior to the adding step" (emphasis added). However, claim 1 has more than one "adding step"; i.e. "adding one or more liquid ingredients..." (See claim 1 on page 9, lines 4-5) and "adding bulky ingredients..." (See claim 1 on page 9, line 8). This makes the claim indeterminate.

Claim 12 recites "at a sufficient temperature for a sufficient time to allow substantial swelling of the starch to form a swelled base". Similarly:

Claims 21 and 27 recite "at a sufficient temperature and for a sufficient time to form a swelled soup base";

Claim 26 recites "at a sufficient temperature for a sufficient time to allow substantial swelling of the starch to occur"; and

Claim 27 recites

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The above recitations of claim 12, 21, 26 and 27 neither define a specific required extent of swelling, nor recite specific temperature or time to achieve the swelling, which makes the claims indeterminate.

Claim 32 recites, "Wherein the soup composition is organic". This limitation is not clear. For example, the food comprises water that is added during the making of the soup and water is an inorganic substance. It is not clear if the reference to "organic" is specifically towards "organically grown ingredients where applicable" or bears reference of use of "organic compounds".

The term "bulky ingredients" and "bulk soup" as recited in claims 1-32 are indefinite, as both are relative terms which render the claims indefinite. The term "Bulky ingredient" or "bulk soup" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Also it is subjective term as what might appear as a bulk soup or a bulky ingredient to one person of the art might not be bulky to another.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 2, 6-8, 11-16, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al (US6221420 B1).

Thomas et al, hereinafter Thomas, teaches of thermally inhibited starches and products made using those starches(Abstract). Thermal inhibition is a form of physical modification of the starch as opposes to the chemical modification of starch by chemical

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cross linking etc. Thus Thomas teaches of physically modified starches, such as, waxy corn starch (Column 5, lines 24-40) as instantly claimed. Regarding claims 1, 12, 26, Thomas also teaches of making soup using the physically modified starch (Column 48, lines 40-68). The process taught by Thomas comprises forming an admixture of dry ingredients and a physically-modified, plant-derived starch (Corn starch, Column 5, lines 26-28) by blending the starch and chicken powder (Column 48, lines 58-59); adding one or more liquid ingredients (water) to the admixture to form a powder slurry; heating the powder slurry at a sufficient temperature for a sufficient time to allow swelling of the starch to form a swelled soup base; and adding bulky ingredients to the swelled soup base to form a bulk soup (column 48, lines 40-68). Thomas also teaches of soup product being heated and held at 250 °F for 30 minutes before cooling the product, thus the starch as taught by Thomas is able to withstand the temperature of 250 °F for 30 minutes. Further Thomas teaches that the starches are thermally treated to up to 125 °C, i.e., about 260°F, thus Thomas teaches of a starch being able to withstand temperature of 260°F as instantly claimed. Furthermore, Thomas is also teaching of maize starch as instantly claimed, the ability of the starch to withstand temperature from the same source will be about the same, thus the starch taught by Thomas will be able to withstand temperatures as high as the maize starch being instantly claimed. Further it is noted that the applicant has not clarified what the term "withstand" encompasses as indicated above in the office action.

Further regarding claims 12 and 28, Thomas teaches of soup product example where the starch component as 3% by weight, liquid component 65% by weight (i.e., about 60%) and 32% bulky ingredients (Column 48, lines 40-55) as instantly claimed. The reference further teaches that the resultant packaged (canned) soup having an equal distribution of particles within each can, which means the particles being suspended in a generally homogeneous composition as instantly claimed.

Regarding claim 2, Thomas teaches of a process for making a soup, filling the soup in the cans, steam retorting to an internal temperature of 120 °C for 30 minutes (i.e.,

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sterilizing) and obtaining a canned soup, i.e., shelf stable. Thus the reference teaches of a soup product as recited in claim 2.

Regarding claim 6, Thomas teaches of blanched vegetable mixture to be added as soup ingredients (Column 48, lines 45-55), thus teaching the precooking of bulking ingredients as instantly claimed.

Regarding claim 7, Thomas teaches of steps of filling containers with the bulk soup and sterilizing by retorting the containers (Column 48, lines 40-68).

Regarding claim 8, Thomas teaches of heating the slurry to 185⁰ F (Column 48, lines 59-61) which falls between about 160⁰ F to about 200⁰ F as instantly claimed.

Regarding claim 11, Thomas teaches of water as the liquid component as instantly claimed.

Regarding claims 12 and 13, Thomas teaches of a generally homogenous soup as discussed above with claims 1, 26 and 28.

Regarding claim 14, Thomas teaches precooking the bulky ingredients as discussed above regarding claim 6.

Regarding claim 15, Thomas teaches of bulky ingredients are vegetables (Column 48, lines 45-55) as instantly claimed.

Regarding claim 16, Thomas teaches of heating the slurry to 185⁰ F (Column 48, lines 59-61) , which falls between about 160⁰ F to about 200⁰ F as instantly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

Resolving the level of ordinary skill in the pertinent art.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

A) Claim 3-5, 9-10, 17-25, 27, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al (US6221420 B1).

The reference is incorporated as cited above. Regarding claim 3, Thomas teaches of heating the powder slurry (mixture) for 10 minutes (about 15 minutes) at a temperature of 85 °C (about 92°C) as instantly claimed. Regarding the viscosity of the starch Thomas teaches of thermal inhibition of starches and presents data that the starch can be physically modified by thermal inhibition to yield various viscosity product (Example 5, Columns 21-24). In an example of waxy maize starch Thomas teaches of a maize starch that has the viscosity of 380 BU at 95° C and 640 BU after 10 minutes, which falls in applicant's recited range. Thus physically modified starches having the viscosity in applicant's recited range were known at the time of the invention. Further physically modified starches were also known to be used in making soups as taught by Thomas above in claim 1, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include the starch that will be most suited for making the soups using the method as recited by Thomas and as instantly claimed. One of ordinary skill in the art at the time of the invention would expect a thermally inhibited starch as taught by Thomas to have viscosity characteristics similar to the characteristics of the starch as recited in claim 3, where the heated soup base has an equal distribution of particles, i.e., the starch ingredient of the

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soup does not separate or settle, which is also the intent of the applicant. Thus to select a starch based on its viscosity to be employed in a method of making soup or sauce or slurry would have been well within the purview of one of ordinary skill in the art at the time of the invention and thus it does not impart patentable distinction to the claims, absent any clear and convincing evidence and arguments to the contrary.

Furthermore, Applicant has described the product with parameters and equations which cannot be measured by the office for prior art comparison, because the office is not equipped to manufacture prior art products and compare them for patentability purposes. Therefore, as a prima facie case of obviousness has been properly established, the burden is shifted to the applicant to show that the prior art product is different.

Regarding claims 4 and 30, Thomas teaches of soup or sauces made by physically modified corn /maize starch as discussed above regarding claims 1 and 28. The reference does not teach of organically grown corn. However, organic foods were well known at the time of the invention (i.e., foods grown before the use of chemical fertilizer were organic foods). It was also known that organic or organically grown foods are considered better at least for the reason that they do not contain the pesticidal residues. Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of making soup as taught by Thomas and add organically grown ingredients at least for the purpose of making the soup with more environmentally friendly foods that are devoid of pesticidal residues. One would have been further motivated to do so in order to make a product that is more desirable to the consumers who demand organic foods.

Regarding claim 5, Thomas teaches swelled soup base, however Thomas does not teach of the viscosity. Soups of low viscosity, i.e., thin broths or consommé and medium viscosity like lightly creamed or pureed soups and high viscosity soups or sauces or foods like the chowders and stews have been known. Further adjusting viscosity of a soup/sauce/grave by either addition of liquids or by evaporation of liquids by heating

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longer was also well known. Thus methods of making soups varying in viscosity were known in the art at the time of the invention. Thus, it would have been well within the purview of one with ordinary skill in the art at the time of the invention, to make the soup having the optimal viscosity desired for the type of soup by either incorporating more liquids or incorporating less liquids or heating the soup longer to evaporate the liquids. One would have been motivated to do so in order to reach an optimal consistency for the soup or sauce or product being made, e.g., in order to make cream of tomato soup having an optimal thickness without having runny or lumpy texture. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the viscosity of the soup in order to achieve optimal desired texture in the finished soup product as instantly claimed.

Regarding claim 9, Thomas teaches of heating the swelled soup base for 30 minutes (Column 48, line 63), which falls in the range of about 20 minutes as instantly claimed. Furthermore, soup bases were known to be heated for varying amounts of time to reduce or thicken the soup or to cook the ingredients to achieve a desired consistency in the finished product. Thus heating the soup base to a specific time to optimize the overall cooking time would not impart patentable distinction to the method of making the product.

Regarding claim 10, Thomas teaches of filling the containers and sterilizing by retorting the containers as recited in claim 7. The reference also teaches of heating the soup product to a temperature of 185° F (about 160° F), prior to the filling step as instantly claimed.

Regarding claims 17 and 18, Thomas teaches of heating the mixture at 185° F for 10 minutes which falls in the recited range of the invention in claim 17. Furthermore, the time and temperature are inversely related in heat production, the higher the temperature, the lesser time it would be required to heat a substance like soup. Also the time of heating depends on the initial temperature of the soup, the batch size, the liquid content, and the solids content of the soup. Therefore, it would be obvious to one of

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ordinary skill in the art to modify the method as taught by Thomas and adjust the time of heating of the soup according to the liquid content, the total batch size and the initial temperature of the soup mixture at least for the purpose of optimizing the heating time for the process. Thus altering the heating time of the soup mixture in the process taught by Thomas would not impart patentable distinction to the claims, absent any clear and convincing evidence and arguments to the contrary.

Regarding claim 19, Thomas teaches the process where the slurry is heated to 185° F for 10 minutes, which falls in the recited range of about 195° F for about twenty minutes.

Regarding claim 20, Thomas teaches of heating the soup product to a temperature of 185° F (about 160° F), prior to the filling step (Column 48, lines 55-68) as instantly claimed.

Regarding claim 21, Thomas teaches A process for making soup, comprising: making a slurry from a physically modified plant-derived starch and a liquid; heating the slurry at a sufficient temperature and for a sufficient time to form a swelled soup base; mixing precooked bulky organic ingredients with the swelled soup base to form bulk soup; and sterilizing the bulk soup (column 48, lines 40-68) Also see the rejection of claims 1, 12, 26 and 28 above. The reference does not teach of process for an organic soup.

However, organic foods were well known at the time of the invention (i.e., foods grown before the use of chemical fertilizer were organic foods). It was also known that organic or organically grown foods are considered better as they do not contain the pesticidal residues. Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of making soup as taught by Thomas and add organically grown ingredients, in order to make the soup with more environmentally friendly foods that are devoid of pesticidal residues. One would have been further motivated to do so in order to make a product that is more desirable to the consumer.

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Regarding claim 22, Thomas teaches a method of making soup where the slurry is heated to 185° F (Column 48, lines 59-61) which falls between about 160° F to about 200° F as instantly claimed.

Regarding claim 23, Thomas teaches the method of making soup where the slurry is heated is to 185° F (Column 48, lines 59-61), which is about 195° F as instantly claimed.

Regarding claim 24, Thomas teaches of heating the mixture is heated for 10 minutes (Column 48, lines 59-61), which falls in the range of about 20 minutes as instantly claimed. Furthermore, soup mixture were known to be heated for varying amounts of time to reduce or thicken the soup or to cook the ingredients to achieve a desired consistency in the finished product. Thus heating the soup base to a specific time to optimize the overall cooking time would not impart patentable distinction to the method of making the product.

Regarding claim 25, Thomas teaches the method of making soup wherein prior to the sterilizing (retorting) step, the steps of preheating the bulk soup and filling glass containers with the preheated bulk soup (Column 48, lines 55-68) as instantly claimed.

Regarding claim 27, Thomas teaches the steps of making soup as discussed above regarding claims 1, 12, 21 and 26. The reference does not teach of organic ingredients. However, organic foods were well known at the time of the invention (i.e., foods grown before the use of chemical fertilizer were organic foods). It was also known that organic or organically grown foods are considered better as they do not contain the pesticidal residues. Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of making soup as taught by Thomas and add organically grown ingredients, in order to make the soup with more environmentally friendly foods that are devoid of pesticidal residues. One would have been further motivated to do so in order to make a product that is more desirable to the consumer.

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Regarding claims 31 and 32, Thomas teaches of soup composition as disclosed in claim 28. The reference teaches of addition of vegetables to the soup, however the reference does not teach of addition of organically grown vegetables as instantly claimed. Organic foods were well known at the time of the invention (i.e., foods grown before the use of chemical fertilizer were organic foods). It was also known that organic or organically grown foods are considered better as they do not contain the pesticidal residues. Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of making soup as taught by Thomas and add organically grown ingredients, in order to make the soup with more environmentally friendly foods that are devoid of pesticidal residues. One would have been further motivated to do so in order to make a product that is more desirable to the consumer.

(B) Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al (US6221420 B1) as applied to claims 1-28 and 30-32 above, further in view of Nash et al (US 3689284).

Thomas has been applied to claims 21 and 28 as discussed above.

Thomas teaches of method of making soup and a soup product made where the heated soup is introduced into the containers (cans) as discussed above (Column 48, lines 55-68). The reference, however does not teach of the clear or glass containers as recited in claims 25 and 29 respectively. Storing foods in glass containers as part of home canning was well known in the art at the time of the invention. Thus one of ordinary skill in the art would have been motivated to look to the art for examples of such containers. Nash et al, hereinafter Nash teaches of storing emulsions, such as sauce or gravy in glass containers (Figure 1 and Column 4, lines 1-10). Nash also teaches of the step of filling the glass containers with hot gravy in the temperature range recited by the applicant (Column 4). Thus hot filling of clear glass containers with emulsions such as gravy or sauce was known in the art at the time of the invention. Therefore one of ordinary skill in the art at the time of the invention would have been motivated to pack the soup composition in the clear containers such as glass in order to give the

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consumer a good view of the product. One would have also been motivated to do so in order to pack the soup in a microwave safe container for the ease of consumption.

Therefore, claims 25 and 29 are rejected by Thomas in view of Nash.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jyoti Chawla
Examiner
Art Unit 1761


KEITH HENDRICKS
PRIMARY EXAMINER